REMARKS

This Amendment After Final is prepared in response to the final Office action mailed on 26 July 2012 (Paper No. 20120721). Allowance of claims 1-42, 46-56, 64-72, 74-84, 90-93, 95-100, 105-116, 119 and 121-127 is appreciated.

Status of the Claims

Claims 1-56, 64-84, 90-100, 105-116 and 119-127 are pending, of which claims 43-45, 73 and 94 have been withdrawn from further consideration by the Examiner. Claims 57-63, 85-89, 101-104, 117 and 118 were previously canceled.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

Claim Rejection under 35 U.S.C. §135

Claim 120 rejected under 35 U.S.C. §135(b)(1) as not being made prior to one year from the date on which U.S. Patent No. 5,839,307 was granted. Applicant respectfully traverses this rejection.

I. The administrative record of Applicant's above-captioned application explicitly admits that Applicant has timely and completely complied with the requirements of 35 U.S.C. §153(b)(1)

In support of this rejection, the Examiner set forth the following "timeline in the instant application," which states, in part, that:

> "In the amendment of 8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim, and in fact, differed substantially. The claim recited a lock cylinder instead of a barrel and recited only one locking member rather than the plurality of locking members set forth in the Field claim. Accordingly, it was patentably distinct from the Field claim and cannot be considered a copied claim."

Applicant respectfully observes that the foregoing paragraph **1.** set forth in Paper No. 20120721, is an explicit written admission by the Examiner that Applicant had timely complied with the statutory requirement of 35 U.S.C. §135(b)(1)by making a claim "for the same or substantially the same subject matter ... prior to one year from the date on which the [Field U.S. Patent No. 5,839,307] patent was granted." 35 U.S.C. §135(b)(1) requires no more.

Therefore, in recognition of the explicit admission upon the administrative record that on, or about "8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim," this final rejection of claim 120 may not be sustained under 35 U.S.C. §135(b)(1).

II. 35 U.S.C. §153(b)(1)explicitly admits that a copied may need not be copied *verbatim* in order to initiate an interference under 35 U.S.C. §153

The text of under 35 U.S.C. §135(b)(1) explicitly states a declaration of interference may be based upon,

> "[a] claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent... ."

In other words, under 35 U.S.C. §135(b)(1) the claim may alternatively be either:

- "the same,"
- "for the same ***subject matter***," or
- "for ***substantially*** the same ***subject matter***."

In Paper No. 20120721, the Examiner explicitly admits that the administrative record that,

> "this claim was not a *verbatim* copy of the Field claim and in fact differed substantially [because the] claim **[1]** recited a lock cylinder instead of a barrel and **[2]** recited only one locking member rather than the plurality of locking members set forth in the Field claim."

These two asserted reasons are inadequate are inadequate findings-of-fact to support a conclusion of law that Applicant failed to comply with 35 U.S.C. §135(b)(1) in the

subject matter of claim 120, nothing in the administrative record negates the fact that a ***barrel*** is in fact characterized in both shape and function, as a cylinder; and the fact that under U.S. claim interpretation, a ***locking member*** encompasses the narrower subject matter of ***a plurality of locking members***."

In short, the foregoing excerpt drawn from Paper No. 20120721 is a *prima facie* admission drawn from the administrative record, that Applicant timely complied with the explicit requirements of 35 U.S.C. §135(b)(1), by presenting a claim for either,

- "the same,"
- "for the same ***subject matter***," or
- "for ***substantially*** the same ***subject matter***."

In a similar manner, both the second paragraph of 35 U.S.C. §112 as well as 35 U.S.C. §112(b), contemplate ***claims*** not in terms of *verbatim* text or identical style, but in terms of **the *subject matter*** which the applicant regards as the invention. Thus, the Examiner's finding-of-fact that,

> "applicant failed to copy the claim within one year of the 11/24/1998 issue date,"

is directed, despite the denial by Paper No. 20120721 to the contrary, to whether Applicant has presented the *verbatim* language of the claim, rather than to whether Applicant has complied with ***substantially*** the same ***subject matter***." by making either the entirety of the claim or to the same ***subject matter*** encompassed by the claim, or to ***substantially*** the same ***subject matter***.

Applicant respectfully submits that this rejection, and the rationale given by Paper No. 20120721 impermissibly denies Applicant the broad flexibility bestowed by of 35 U.S.C. §135(b)(1) when drafting the claim.

Consequently, these findings-of-fact taken from the explicit statements of the administrative record, do not support the foregoing rejection under 35 U.S.C. §135(b)(1). A refusal to sustain this rejection is therefore respectfully requested.

III. 35 U.S.C. §153(b)(1) does not deny an applicant the right to amend, cancel or substitute a claim for "the same," "for the same *subject matter*," or "for *substantially* the same *subject matter*."

Applicant respectfully observes that once made, nothing in 35 U.S.C. §153(b)(1) denies an applicant the right to amend, cancel or substitute a claim for "the same," "for the same ***subject matter***," or "for ***substantially*** the same ***subject matter***," or purports to limit the time when an applicant may amend, cancel or substitute a claim for "the same," "for the same ***subject matter***," or "for ***substantially*** the same ***subject matter***." Paper No. 20120721 explicitly acknowledges that Applicant's above-captioned pending application has continuously preserved one, or more claims that encompassed either "the same" claim as Field '307, or claims "for the same ***subject matter***," or "for ***substantially*** the same ***subject matter***" across the multi-decade prosecution history of this application.

In specific detail, Paper No. 20120721 tracks the administrative record by observing that,

> "In the amendment of 10/6/1999, applicant cancelled claim 60."
>
> "The amendment of 11/30/1999 was not entered."
>
> "In the amendment of 3/16/2000, applicant added new claims 85 and 89 directed to a "lock cylinder". Once again, this differed from the Field claim as discussed above."
>
> "In the amendment of 4/24/2000, applicant amended claims 85 and 89 to include in claim 85, "blocking" as in the Field claim, but did not cure the absence of the plurality of locking members set forth in Field; and in claim 89, changed to "alignment", but did not cure the omission of the plurality of locking members."
>
> "In the amendment of 4/13/2001, applicant filed new claim 120, which is a verbatim copy of the Field claim 14."

Applicant respectfully observes that nothing in 35 U.S.C. §133 purports to inhibit the right of an applicant to amend, cancel, replace or substitute on claim for another, and as earlier noted, 37 CFR §121(c) explicitly contemplates all manner and techniques for amendment.

Consequently, the Examiner's finding-of-fact that,

> "Thus, applicant failed to copy the claim within one year of the 11/24/1998 issue date,"

is unsupported by the administrative record, by 35 U.S.C. §112 and §135(b)(1), and there is therefore, no evidentiary basis in the administrative record able for sustaining this rejection.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Fees

No fee is incurred by this Amendment After Final. Should any fees be required under 37 C.F.R. §1.16 or 37 C.F.R. §1.17 however, the Examiner is respectfully requested to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney such fee(s).

Respectfully submitted,

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